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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,617	10/25/2001	Shell S. Simpson	10007679-1	3072

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

THOMAS, ASHISH

ART UNIT PAPER NUMBER

2625

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,617

Applicant(s)

SIMPSON, SHELL S.

Examiner

Ashish K. Thomas

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 9/19/2006 have been fully considered but they are not persuasive.

The Applicant contends in page 14, 2nd paragraph of the Remarks that "Tammi only discloses sensing means of the post processing system that track the machine cycles of the system. Nowhere is it actually stated that any determination of whether a print-to-mail format document was generated is made."

In reply, please refer to column 10, lines 9-15 of Tammi. It reads:

"The position of each mail within the post processing system 70 is generally tracked by encoder sensor means which provide for keeping track of the machine cycle of each device 75-95 within the post processing system 70, and thus *the position or location of printed mail statement.*"

Tammi teaches a method that tracks the position or location of the print-to-mail document. By tracking the location of the print-to-mail document, Tammi in essence has the capability to determine or "sense" if processes such as printing, folding or sealing have been achieved at the respective device that performs these process. Note that the last process performed on the print-to-mail document is sealing. Before a print-to-mail document is sealed, it has been obviously printed and also folded. The determination that a document has been sealed thereby inherently instructs that a document has been printed and folded. So when it has been "sensed" or determined

that the print-to-mail document is at a device that seals, it has also been determined that the print-to-mail document was printed, folded, and sealed as a mailing.

Furthermore, the Applicant asserts in page 14, 3rd paragraph of the Remarks that "the Examiner acknowledges in the final office action that Tammi fails to teach a print-to-mail format document but points to Applicant's Background section as admitting that such documents are known."

In reply, the Examiner believes the Applicant misunderstood the Examiner's response on the previous office action. Please note that the Examiner *did not acknowledge* that Tammi fails to teach a print-to-mail format document. What the Examiner acknowledged in the previous office action was Tammi's shortcomings in teaching a print-to-mail document as described in claims 28 and 33-35. So for claims 28 and 33-35, the Examiner incorporated the Applicant's admitted prior art in making the rejection; a proper motivation is put forth as well.

Consequently, this office action is made a **Final Rejection**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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1. Claims 1-7, 12-15, 18, 21, 26-29, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi(US patent 5,726,897) in view of Gleason(US patent 5,091,777).

Regarding claim 1, Tammi discloses a method for print-to-mail notification, comprising:

determining that a print-to-mail format document has been printed, folded, and sealed as a mailing (column 4, lines 27-42 and column 10, lines 4-35);

generating notification information that identifies that the print-to-mail format document has been printed, folded, and sealed as a mailing (column 4, lines 27-42).

Post processing includes folding and sealing as disclosed in column 7, lines 15-27. Also note that described in column 10, lines 4-35 is a method that detects if post processes such as folding and sealing have been accomplished by the post processing system 70; this references specifically indicates that the completion of post processes such as folding and sealing are communicated. Tammi discloses in column 4, lines 40- 42 that post processing means can also verify receipt and matching of printed statement. Verifying receipt of document is considered equivalent to generating notification information.

However, Tammi does not disclose the step of identifying attributes of the print-to-mail format document.

Gleason discloses the above limitation in column 5, lines 27-30.

Tammi and Gleason are combinable because they are from the same field of endeavor that is document assembly for mailing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to identify the attributes of the print-to-mail document.

The suggestion/motivation for doing so would have been to correlate a mailing with a specific recipient.

Therefore, it would have been obvious to combine Tammi and Gleason to obtain the invention as specified in claim 1.

Regarding claim 2, Tammi discloses the method of claim 1, wherein determining that a print-to-mail format document has been generated comprises detecting that the print-to-mail document has been printed, folded, and sealed(column 4, lines 40-42 and column 10, lines 4-35).

Regarding claim 3, Tammi discloses the method of claim 1, wherein determining that a print-to-mail format document has been generated comprises receiving a notice from a print-to-mail device component configured to fold and seal the document (column 4, lines 40-42 and column 10, lines 4-35).

Regarding claim 4, Gleason discloses the method identifying document of claim 1 wherein attributes comprises identifying at least one of a name of the document, a date the document was printed, and a name of a user (column 5, lines 28-30).

Regarding claim 5, Gleason discloses the method of claim 1, wherein identifying document attributes comprises identifying at least one of a customer name, a customer number, a billing period to which the document pertains (column 5, lines 28-30).

Regarding claim 6, Gleason discloses the method of claim 1, wherein generating notification information comprises generating notification information that identifies at least one of the document attributes (column 5, lines 21-30).

Regarding claim 7, Tammi discloses the method of claim 1, further comprising transmitting notification information to a computing device(column 4, lines 52-60).

Regarding claim 26, Gleason discloses the device of claim 21, wherein the at least one attribute comprises at least one of a name of the document, a date the document was printed, and a name of a user (column 5, lines 28-30).

Regarding claim 29, Tammi discloses the device of claim 28, wherein the recipients are customers of a business and the mailings comprise bills that are to be mailed to the customers (column 1, lines 20-38).

2. Claims 8-10, 16, 19, 24-25, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi(US patent 5,726,897) in view of Gleason(US patent 5,091,777) and further in view of Stewart(US patent number 6,717,964).

Regarding claim 8, Tammi and Gleason fail to disclose the method of claim 7, wherein transmitting notification information comprises transmitting notification information to a remote computing device via a network.

However, Stewart discloses this limitation in abstract.

Tammi, Gleason, and Stewart are combinable because they are from the same field of endeavor that is printing services.

At the time of the invention, it would have been obvious to a person ordinary skill in the art to store notification information in a remote computing device (web server).

The suggestion/motivation for doing so would have been to enable a user to view images remotely.

Therefore, it would have been obvious to combine Tammi, Gleason, and Stewart to obtain the invention as specified in claim 8.

Regarding claim 9, Stewart discloses the method of claim 7, wherein transmitting notification information comprises transmitting the information to a database from which data contained within the print-to-mail format document originated (abstract).

Regarding claim 10, Tammi does not disclose the method of claim 9, wherein the database is supported by a network-based database management system. It is well known that data bases in a network are supported by network-based database management system.

Regarding claim 19, Tammi discloses the device of claim 18, wherein the hard copy generation hardware comprises a print engine (printer 30).

Regarding claim 24, Stewart discloses the device of claim 18, further comprising an embedded web server that supports a print-to-mail service that is accessible over a network (column 2, line 33).

Regarding claim 25, Stewart discloses the device of claim 24, wherein the service comprises a print-to-mail web service that is accessible over the Internet (column 2, line 33).

3. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent 5,726,897) in view of Gleason (US patent 5,091,777) and further in view of Pollard(US Patent 5,745,590).

Regarding claim 11, Tammi in view of Gleason do not disclose the method of claim 1, further comprising storing the notification information within memory of a print-to-mail device that printed, folded, and sealed the print-to-mail format document.

However, Pollard discloses in column 5, lines 29-37 memory 34 for storing information regarding diverted mail pieces.

Tammi, Gleason and Pollard are combinable because they are from the same field of endeavor that is document assembly for mailing.

At the time of the invention, it would have been obvious to a person ordinary skill in the art to store notification information within the memory.

The suggestion/motivation for doing so would have been to establish a reprint file.

Therefore, it would have been obvious to combine Tammi, Gleason and Pollard to obtain the invention as specified in claim 11.

4. Claims 28, 33, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent 5,726,897) in view of Gleason (US patent 5,091,777), Pollard(US Patent 5,745,590), and the Applicant's admitted prior art.

Regarding claims 28, 33, 34, and 35, Tammi, Gleason, and Pollard does not explicitly state that the print-to-mail format document does not require an envelope for purposes of mailing once it has been folded and sealed as a mailing.

Page 1, lines 14-20 of the current application's specification discuss known prior art wherein a bill is sealed and folded, an envelope is not used here.

Therefore, it would have been obvious for one of ordinary skill in the art to modify Tammi, Gleason, and Pollard with the admitted prior art to come up with a method wherein the print-to-mail format document does not require an envelope.

The motivation for this combination is that it enables a printed media to be mailed as opposed to putting the printed media on an envelope and then mailing it; an envelope is not needed to mail something.

5. Analogous Claims.

Regarding claim 12, arguments analogous to those presented for claim 1, are presented.

Regarding claims 13, 21, arguments analogous to those presented for claim 4, are presented.

Regarding claims 14, 27, arguments analogous to those presented for claim 5, are presented.

Regarding claim 15, arguments analogous to those presented for claim 7, are presented.

Regarding claims 16, 23, 31, arguments analogous to those presented for claim 8, are presented.

Regarding claim 17, arguments analogous to those presented for claim 11, are presented.

Regarding claims 18 and 32, arguments analogous to those presented for claim 1 and 11, are presented.

Regarding claim 22, 30, arguments analogous to those presented for claim 9, are presented.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

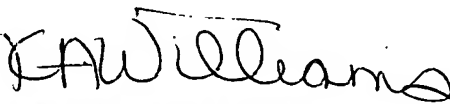
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashish K. Thomas whose telephone number is 571-272-0631. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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